REMARKS

At the outset, the Applicant wishes to thank Examiner Paradiso for his courtesy in allowing a telephonic interview with the undersigned attorney on December 8, 2004. An interview summary is being filed herewith. Applicant submits that all the pending claims are patentable over the art of record.

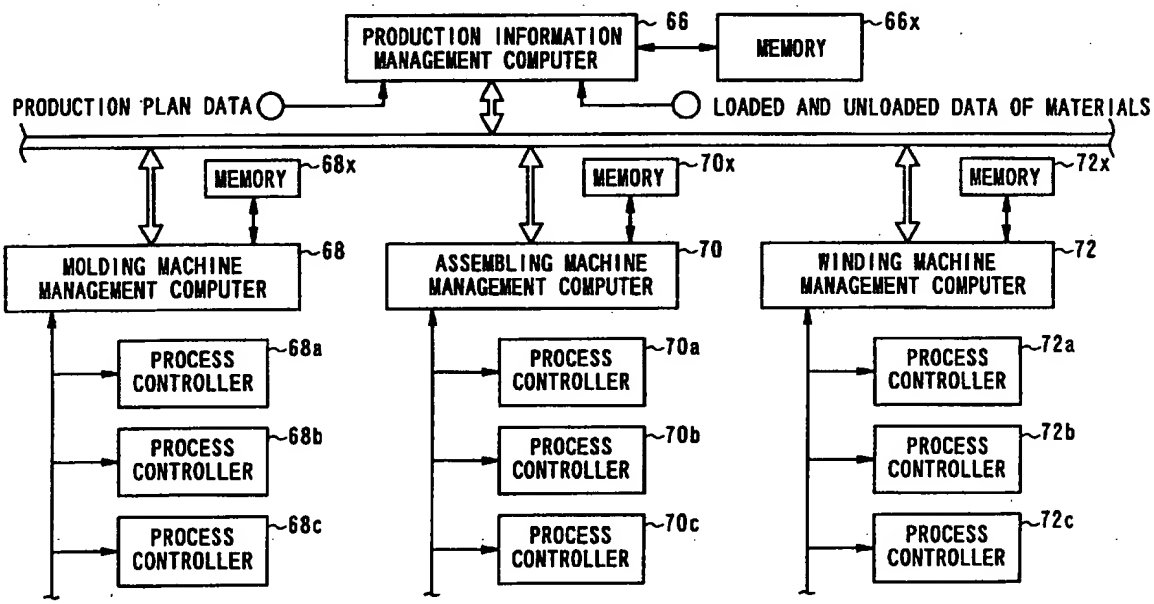
The rejection of all claims over U.S. Patent No. 6,155,025 to Komiya et al. (Komiya) was made final in the Office Action of September 9, 2004. Claims 1, 2 and 6 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Komiya and claims 3-5 and 7-13 stand rejected under 35 U.S.C. § 103 are being unpatentable over Komiya. Applicant respectfully traverses these rejections and submits that all claims are allowable.

Claim 1 recites a "packaging system for packaging a plurality of individually articles into packs and for collecting together a plurality of packs in to a packaged unit" and includes a "respective connecting means" each of which further includes a "means to translate data bus commands appropriate to that component into, a command protocol which is read by the connected component which responds by performing a productive function, whereby the control means is able to control each of the connected components independent of command protocols recognized by the connected components."

As provided on page 6 of the Specification and Figure 1, at least some if not all of the components, such as an article weight station 11, marking means (including, for example, inkjet or thermal transfer printers), palletiser 30, and wrapper mans 31, which are "connected to the data bus 10 may emanate from alternative manufactures, or even when the same manufacturer may be of different generations or otherwise may be incompatible from a control point of view."

The invention provides and recites in claim 1, a common computer protocol to be used by the control means, and the respective connecting means then translates the commands to the command protocol actually used by the connected components. As asserted in Applicant's previous office action responses, the passages of Komiya at columns 4-6 and 9-12 and figure 1 (provided below), figures 2 and 19 merely describe how a controller controls various mechanisms and patterns and how computer 66 controls various process controllers.

FIG. 1



Nowhere does Komiya disclose or suggests a "respective connecting means" for each of a first, second, and third marking means and for a means for collecting the plurality of packs into a single packaged unit where each respective collecting means includes a "means to translate data bus commands appropriate to that component into, a command protocol which is read by the connected component which responds by performing a productive function, whereby the control means is able to control each of the connected components independent of command protocols recognized by the connected components." Therefore, for Komiya to anticipate claim 1, the recited feature must be inherently disclosed.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631 (Fed. Cir. 1987). Even if the reference does not explicitly disclose every element, "[i]t is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it. Under the principles of inherency, if the prior art reference functions in accordance with, or includes the claimed limitations, it anticipates." In re Cruciferous Sprout Litig., 301 F. 3d 1343 (Fed. Cir. 2002).

"To establish inherency, the evidence must make clear that the missing descriptive matter is 'necessarily present' in the material described in the reference, and that it would be so recognized by persons of ordinary skill in the pertinent art." Wesley Jessen Corp. v. Bausch & Lomb, 209 F.Supp.2d 348, 392 (D. Del. 2002) citing Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268 (Fed. Cir. 1991); In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999) (noting that inherency cannot be established by probabilities or possibilities). "Although recognition of an element in the prior art before the critical date is not necessary, inherent anticipation still requires that the element necessarily be present." Schering Corp. v. Geneva Pharms., 339 F.3d 1373, 1377 (Fed. Cir. 2003).

Rather than operating like the invention as recited in claim 1, the system of Komiya could (1) rely on equipment being replaced by equipment which operates according to the same protocol as the replaced equipment or (2) rely on reprogramming of the computer controller. Accordingly, the "respective connecting means" including the "means to translate" is not *necessarily present* in Komiya as required for anticipation by inherency under the Federal Circuit authority cited above and MPEP § 2112. Accordingly, Komiya fails to anticipate claim 1.

Moreover, Applicant provides supporting evidence that there is no inherent disclosure in Komiya of the claimed subject matter in the Rule 132 Declaration of Paul Mills, filed on June 1, 2004, and attached hereto for the convenience of the Examiner (Mills Declaration).

> In such an automated packaging system, it is typical that some if not all of the components, such as the first, second and third marking means, the packing means, the means to collect, may emanate from alternative manufacturers, or even when from the same manufacturer may be of different generations or otherwise may be incompatible from a control point of view. Each of the connected components requires the appropriate command protocols, which typically would be particular to a specific component, in order to perform a productive function such as "print" or "wrap."
>
> Mills Declaration, ¶4.

As provided in Mr. Mills' statement, the "connecting means" and "means to translate" of claim 1 are not only not necessarily present, but rather, it is more likely that the Komiya system would be implemented differently. In any event, inherency cannot be established by probably or possibilities, it must necessarily follow from what is actually disclosed. See In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999). "The mere fact that a certain thing may result from a given set of circumstances is not sufficient." In re Oelrich, 666 F.2d 578, 581 (CCPA 1981).

The Office Action of January 29, 2004, referenced in the outstanding Office Action, states that the "respective connecting means" and the "means to translate" are inherently disclosed in Komiya.

> [T]he connecting of a elements of a machine with a controller, such as connecting a printer or floppy drive to a computers CPU or connecting remote sensors and machine control circuits to a PLC, is inherent in structure and is necessary when any components are connected via a data bus to a controller. The same principle applied to a means for translating date bus commands: if this were not so, the above examples of a computer would not be able to communicate with or recognize the printer of floppy drive and the example of a machine with remote

> sensors and control circuits would not be able to communicate or receive instructions from the PLC.
>
> Office Action, dated January 29, 2004 at ¶5.

However, when the "means to translate data bus commands" limitation is afforded the broadest reasonable scope in view of the supporting specification, the rejection based on Komiya should be withdrawn. In particular, the "means to translate data bus commands" limitation includes "whereby the control means is able to control each of the connected components independent of command protocols recognized by the connected components." Nothing in Komiya discloses, teaches or suggested this feature. Conventionally, loading differing components on a packaging system necessitates reprogramming the computer controller (such as, for example, loading new device drivers onto the computer for each new connected component). Moreover, Mr. Mill's testimony from the paper filed on June 1, 2004, further supports that Komiya fails to disclose this feature.

> I disagree with the examiner's conclusion. There is no reason to assume that each component [of Komiya] has a "respective connecting means" with a means to translate the data bus commands to commands appropriate to the specific device. Instead, it is more likely to assume Komiya envisaged that if an item of equipment were to be replaced, it would be replaced by an item which operates according to the same protocol (as the one being replaced) or else, that the computer controller is reprogrammed (e.g., to use a new driver for the new component) to cope with such a new item of equipment.
>
> Mills Declaration at ¶10.

It is respectfully submitted that the rejection of claim 1 on Komiya should be withdrawn, and that claim 1 should be allowed. All of the remaining claims depend on claim 1 and are allowable for at least the same reasons.

Enclosed is a $120 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050, referencing the attorney docket number above.

Respectfully submitted,

Date: 1/10/2005

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Paul Mills
Serial No. : 09/728,395
Filed : December 1, 2000
Title : PACKAGING CONTROL WITH TRANSLATION OF COMMAND PROTOCOLS

Art Unit : 3721
Examiner : John Roger Paradiso

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

INTERVIEW SUMMARY

On December 8, 2004, Examiner Paradiso conducted a telephonic interview with Frank Occhiuti and David Schuler, Attorneys for the Applicant.

Claim 1 was discussed in view of U.S. Patent No. 6,155,025 to Komiya. The Attorneys for the Applicant requested clarification of the anticipation by inherency rejection of the Komiya reference. The Attorneys for the Applicant indicated that the invention was distinguishable from components of the commonly available PC or PLC, made of record by Official Notice by the Examiner in Office Action of July 1, 2003, in that the invention did not require the loading of different device drivers required by for differing connected components. The Examiner responded that such device drivers or the lack thereof were not explicitly recited in the claims. In response, the Attorneys for the Applicants referred to the language of claim 1 reciting "means to translate" including "whereby the control means is able to control each of the connected components independent of command protocols recognised by the connected components" to provide the requisite claim scope.

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

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Signature

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Please apply any charges or credits to deposit account 06-1050, referencing the attorney docket number above.

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Attorney's Docket No.: 11033-063001 / A9942US-DJL

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Serial No. : 09/728,395
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P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION OF UNDER 37 CFR 1.132

1. My present position is Software Platform and Product Line Manager at Markem Technologies Limited, a position I have held since October 2003. Before that I was Engineering Manager at Markem Technologies Limited from June 2002 until October 2003 and prior to that have held the same positions but during different time periods from August 1995. Before that I graduated from Oxford Brookes University with a masters degree in Business Administration. My first higher education qualification was in Electrical and Electronic Engineering in which I specialized in software systems. I am familiar with and have nine years of experience in computerized packaging system control. This experience has been developed over the years I have worked with Markem being responsible for the development of a software based packaging equipment control system as well as numerous items of package coding equipment such as thermal transfer printers. Previous to this I spent ten years in the business of road traffic monitoring and data communication systems for use of the public highway. Computer control and communication means were at the heart of these systems.

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May 27, 2004
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Jennifer Leveille
Signature

Jennifer Leveille
Typed or Printed Name of Person Signing Certificate

2. I have read the above-captioned patent application, the Office Action therein dated January 29, 2004, the Reply to Office Action of July 1, 2003 therein, and Komiya U.S. Patent No. 6,155,025 discussed in the Office Action and Reply.

3. The patent application describes a system which automatically packages a plurality of individual articles into packs at a "packing means" (e.g., an automated packing machine), and collecting the packs together into packaged units, each of which includes a plurality of the packs, at a "means to collect", e.g., a palletizer. Along the way, individual articles are marked at first marking means; the packs are marked at a second marking means, and the packaged units are marked at a third marking. There also are first, second and third conveying means for conveying the packs and packaged units, and a control means that controls operation by instructions sent over a data bus using a common computer protocol. Each of the individual first, second and third marking means and the means to collect are connected to the data bus by "respective connecting means," each of which includes "means to translate data bus commands appropriate to that component into a command protocol which is read by the connected component which responds by performing a productive function, whereby the control means is able to control each of the connected components independent of command protocols recognized by the connected components."

4. In such an automated packaging system, it is typical that some if not all of the components, such as the first, second and third marking means, the packing means, the means to collect, may emanate from alternative manufacturers, or even when from the same manufacturer may be of different generations or otherwise may be incompatible from a control point of view. Each of the connected components requires the appropriate command protocols, which typically would be particular to a specific component, in order to perform a productive function such as "print" or "wrap."

5. The patent application describes using a common computer protocol by the control means, and having the respective connecting means for each of the components then translate the commands from the control means to the command protocol actually used by the connected component, as is described at page 7 of the specification.

6. With the system described in the application, if one needs to replace one of the components with a new component, (e.g., and updated printer) there is no need to reprogram the controlling computer, because each component includes a "respective connecting means" each of which includes "means to translate" computer control commands appropriate to that component into a command protocol which is read by the connected component. Thus, the computer controller would only ever have to instruct the item of equipment to operate (e.g., "print") and this command would be translated by the connecting means to a command appropriate to the particular item of equipment, i.e., no re-programming of the computer controller is required merely because a replacement printer, or other item of equipment, has been inserted into the packaging system.

7. Komiya does not explicitly describe such a system, and there is no reason to assume from what is said in Komiya that the system described in Komiya would have "respective connecting means," each of which includes "means to translate data bus commands appropriate to that component into a command protocol which is read by the connected component" such that the control means is able to control each of the connected components independent of command protocols recognized by the connected components.

8. I have in particular reviewed the passages of Komiya referenced in the office action, namely, columns 4-6 and 9-12 and the Figures 1, 2 and 19. These passages and figures merely describe how a controller controls various mechanisms and patterns and how computer 66 controls various process controllers. Komiya nowhere discloses or suggests a "respective connecting means" for each of a first, second and third marking means and for a means to collect where each respective connecting means includes a "means to translate data bus commands appropriate to that component into a command protocol which is read by the connected component which responds by performing a productive function, whereby the control means is able to control each of the connected components independent of command protocols recognized by the connected components."

9. In the office action it is asserted that the missing "means to translate" claim limitations can be considered to be present in Komiya under principles of inherency in the following passage.

> Note that KOMIYA ET AL. does not specifically refer to the data bus that transmits signals and translations of commands from the controller to the peripheral units, however, these limitations are inherent in the invention of KOMIYA ET AL: the connecting of a elements of a machine with a controller, such as connecting a printer or floppy drive to a computers CPU or connecting remote sensors and machine control circuits to a PLC, is inherent in structure and is necessary when any components are connected via a data bus to a controller. The same principle applied to a means for translating data bus commands: if this were not so, the above examples of a computer would not be able to communicate with or recognize the printer of floppy drive and the example of a machine with remote sensors and control circuits would not be able to communicate or receive instructions from the PLC.

10. I disagree with the examiner's conclusion. There is no reason to assume that each component has a "respective connecting means" with a means to translate the data bus commands to commands appropriate to the specific device. Instead, it is more likely to assume Komiya envisaged that if an item of equipment were to be replaced, it would be replaced by an item which operates according to the same protocol (as the one being replaced) or else, that the computer controller is reprogrammed (e.g., to use a new driver for the new component) to cope with such a new item of equipment.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patents issued thereon.

Applicant : Paul Mills
Serial No. : 09/728,395
Filed : December 1, 2000
Page : 5 of 5

Attorney's Docket No.: 11033-063001 / A9942US-DJL

Date: 21st May 2009

Name (typed): Paul Mills

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